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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,095	03/31/2000	Richard Thomas Box	AND1P051F	2254
29838	7590	11/03/2004	EXAMINER	
OPPENHEIMER WOLFF & DONNELLY, LLP (ACCENTURE) PLAZA VII, SUITE 3300 45 SOUTH SEVENTH STREET MINNEAPOLIS, MN 55402-1609			POND, ROBERT M	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/540,095

**Applicant(s)**

BOX, RICHARD THOMAS

**Examiner**

Robert M. Pond

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 40-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

All previously presented claims pending (40-70) were examined in this non-final Office Action necessitated by new grounds of rejection.

### ***Response to Arguments***

Applicant's arguments, see Remarks, filed 30 July 2004, with respect to the rejection(s) of claim(s) 40-70 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Chelliah, IRA, and TForms.

- Pertaining to Claim 40
  - Managing a user's transaction: Chelliah teaches supplier to customer, not business to government interaction:

Chelliah teaches an electronic commerce mall connecting a plurality of customers to a plurality of web-based service providers. Any government entity that engages in online commerce to provide a service to its citizens is a service provider. Each service provider has an electronic storefront managed by the electronic mall (please note: this is equivalent to a portal), and each storefront being selectable by a customer. Furthermore, a customer is a customer regardless whether

the individual is just acting on his/her own behalf or as an employee for a business. Where is the limitation in Chelliah that forbids the customer to represent a business entity? Regardless, Chelliah and IRA teach a business-to-government online transaction and interface to facilitate a business submitting an online electronic form for processing by a government entity.

- Corba is not a standard:

Reliance on Corba is withdrawn. Chelliah and IRA teach transaction data conforming to a standard being from one of the government. Specifically, IRA teaches a standard form converted into an electronic form for online access, completion, and filing (U: see at least page 2).

- User Access to previous transactions:

Chelliah and IRA teach logging customer transactions for analysis and filing tax reports online, but fall short of giving the customer access to this information. TForms supplies supporting teachings in the field of electronic filing of tax forms, storing information in databases, and pre-populating the electronic form with the customer's previous year's return information to speed up the tax filing process. Prior art considered pertinent to pre-filing electronic forms but not relied upon can be found in "Conclusion."

- Fleming fails to teach a receiving government agency is determined from among the plurality of government agency; single portal selection:

Chelliah teaches a single portal and customers selecting a plurality of service providers through the portal. IRA teaches or suggests a customer selecting from a plurality of government agencies. Automatic routing of one form submitted to Inland Revenue results in two additional agencies receiving the same electronic form clearly suggests that the customer can submit forms directly with the other government agencies as well. Regardless, the teachings of Chelliah providing customers access to a plurality of service providers is sufficient in view of IRA.

- Chelliah does not teach digital certificates:

Chelliah and IRA teach the use of digital certificates and digital signatures used to transmit electronic forms to one or more government agencies.

- Personalized interface:

As previously cited, Chelliah displays information using narrowcasting to target the customer based on customer's demographics or purchasing habits (please note examiner's interpretation: targeting customer based on customer profile information). The Examiner believes Chelliah's teachings are sufficient. Please see a) PTO-892, Item: WW for additional information on BroadVision, profiling, and personalizing the customer interface based

on customer profile information, and b) Dedrick on teachings for personalizing information based on customer profile information.

- *Dependent Claims are allowable for the reasons noted above:*

Chelliah or in combination with IRA and TForms teach all dependent claims except Claim 51. BroadVision was cited to support Chelliah regarding search engines (BroadVision is the Assignee of Chelliah). Proctor (Paper #15) remains as a supporting teaching for intrusion detection (Claims 54-55 and 62).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1. Claims 40-50, 52, 53, 56-61, and 63-70 are rejected under 35 USC 103(a) as being unpatentable over Chelliah et al. (Paper #21, patent number 5,710,887, hereinafter referred to as "Chelliah"), in view of Inland Revenue Agency (a collection of prior art cited in Paper #21, PTO-892, Item: U and PTO-892, Item: U hereinafter referred to as "IRA"), further in view of Tax Forms (PTO-892, Item: V hereinafter referred to as "TForms").**

Chelliah teaches a system and method of an electronic mall that facilitates commercial transactions between a plurality of system users (please note: referred to as customers by Chelliah) and at least one provider of goods and services. Chelliah teaches customers interacting online with service providers (please note examiner's interpretation: any government entity that engages in online commerce to provide a service to its citizens is a service provider).

Chelliah teaches each service provider having an electronic storefront managed by the electronic mall (please note: this is a portal) (please see at least abstract; col. 1, lines 20-22; col. 6, lines 4-57; col. 14, lines 47-48). Chelliah further teaches:

- Registering a system user, creating a system user profile: (see at least col. 7, lines 17-19; col. 10, lines 18-25; col. 26, lines 15-19).
- Receiving identification information from the system user: participant program object; use of passwords to secure user information (see at least Fig. 9 (216); col. 9, lines 30-38; col. 9, line 62 through col. 10, line 2; col. 10, lines 28-30; col. 9, lines 49-51).
- Providing secure access to services: Security Subsystem; secure and reliable order and financial transaction processing; RSA public key encryption technology (see at least col. 6, lines 58-65; col. 7, line 15; col. 9, lines 8-19).
- Services limited based on the user profile: narrowcasts targeted services to user based on user's demographics or purchasing habits as defined by participant subsystem and customer accounts subsystem (see at least col. 12, lines 34-42).
- Performing billing functions: receiving electronic payment from user (see at least col. 15, lines 43-49; col. 16, lines 3-20).
- Graphical user interface: communicates with plurality of providers; selects provider; selects products or services (see at least col. 6, lines 31-43; col. 7, lines 46-48; col. 12, lines 43-44).
- Meeting provider requirements: a quantity requirement (see at least col. 18, lines 46-48); meeting a minimum requirement (see at least col. 21, lines 45-47).



- Confirming receipt: confirms; generates receipt (see at least col. 4, lines 27-29; col. 17, lines 31-35).
- Determining tax information: tax engine calculates tax (see at least col. 11, lines 19-24).
- Determining modes of communication: computer, telephone, interactive TV, set-top box, touch sensitive screen (please note examiner's interpretation: system determines mode of communication based on meeting needs of provider) (see at least col. 6, lines 31-34).
- Format and data structure: HTML; object structure, CORBA (see at least col. 14, lines 31-39).
- Customer customized user interface: displays information using narrowcasting to target the customer based on customer's demographics or purchasing habits (please note examiner's interpretation: targeting customer based on customer profile) (see at least col. 9, line 64 through col. 10, line 2; col. 12, lines 34-42).
- Managing transaction information from the user; conform to standards of a government entity:

Chelliah teaches all the above as noted under the 103(a) rejection and teaches a) transforming a manual activity with a service provider into an electronic commerce medium activity, b) a system and method of managing a plurality of customers selecting from among a plurality of service providers connected via an electronic mall (please note: equivalent

to a portal in providing many-to-many access through a single commerce site), c) a service facilitating online transactions with customers according a standard (please note: standards set by the electronic mall and/or standards implemented by each service provider's legacy system), and d) customers submitting electronic communications using HTML formatted documents with a provider of products or services resulting in an electronic transaction, and e) interacting with a plurality of service providers. Chelliah, however, does not teach the transaction data conforming to a standard being from one of the government agencies. IRA teaches replacing manual activity by conducting business with government departments over the Internet to save money. IRA teaches citizen-to-government online interaction and business-to-government online interaction conforming using electronic forms supplied by the government service provider and receiving completed electronic forms online according to a standard (e.g. standard form CWF1, Inland Revenue self-assessment tax form for businesses, US electronic filing) (Paper #21, U: see at least pages 1 and 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Chelliah to disclose a government agency as a service provider transacting business with citizens and businesses through an electronic interface according to a standard as taught by IRA, in order for government agencies to participate in an electronic commerce mall

system, and thereby encourage businesses to submit filings electronically to save money.

- Digital Certificate:

Chelliah teaches all the above as noted under the 103(a) rejection and teaches a) public key encryption technology, b) computing an encrypted payment authorization token based upon the password entered by the user, c) validating the customer's authority, and d) use of digital signatures (see at least col. 16, lines 16-20), but does not disclose digital certificates. IRA teaches all the above as noted under the 103(a) rejection and teaches a) CertCo digital certificate solution supporting Inland Revenue's electronic forms system, b) filing entities digitally signing information and transmitting certificates, and c) authenticating the filer as reliably as with traditional paper documents (U: see pages 1-2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Chelliah to implement the transmission of digital certificates as taught by IRA, in order to authenticate the filer as reliably as with traditional paper documents, and thereby attract filers to the service.

- Filing a report

Chelliah teaches all the above as noted under the 103(a) rejection and teaches customers conducting electronic commerce with a plurality of service providers and selecting among a plurality of business suppliers, but does not disclose filing a report. IRA teaches all the above as noted

under the 103(a) rejection and teaches a) citizens or businesses filing electronic forms with government agencies, and b) the system automatically routing the form to three different government departments (please note examiner's interpretation: automatic routing of one form submitted to Inland Revenue results in two additional agencies receiving the same electronic form clearly suggests that the customer can submit forms directly with the other government agencies as well) (U: see at least pages 1 and 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Chelliah to implement filing a report among a number of government agencies as taught by IRA, in order to conduct electronic form filing activities with a service provider providing government services.

- Report filing based in part on user access to history:

Chelliah and IRA teach all the above as noted under the 103(a) rejection and teach a) tracking and recording customer transactions for historical or real-time analysis (see at least col. 7, lines 40-45; col. 25, lines 65-67), b) the system taking an action and presenting information back to the customer based on past tracked transactions (see at least col. 25, lines 38-67), c) the customer filing a report online with a government entity, and further teach filing tax forms electronically, but do not disclose the report based on at least information from a previous government filing and the user profile. TForms teaches a) speed sells in the tax preparation

field, b) electronic filling of tax returns, and further teaches Tax Works from Laser Systems tracking data entry history so that the software will automatically fill out appropriate information from the customer's prior year's return (please note examiner's interpretation: history information is a profile of the filer) (V: see at least page 5). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Chelliah and IRA to implement automatic filling of customer filing history data as taught by TForms, in order to speed up the process of a customer completing electronic forms, and thereby attract customers to the electronic forms filing service.

- 2. Claim 51 is rejected under 35 USC 103(a) as being unpatentable over Chelliah (Paper #21, patent number 5,710,887), IRA (a collection of prior art cited in Paper #21, PTO-892, Item: U and PTO-892, Item: U), and TForms (PTO-892, Item: V), as applied to Claim 46, further in view of BroadVision (PTO-892, Item: W).**

Chelliah, IRA, and TForms teach all the above as noted under the 103(a) rejection and teach a) accessing service providers through an electronic mall, b) filing reports using electronic forms, and c) making selection from an electronic catalog, but do not disclose a search engine. BroadVision teaches a) search engines that let customers find the exact products they are looking and finding items they desire (W: see at least pages 3 and 4), b) BroadVision supplying

Prodigy's Network Shopping Mall with its Internet commerce platform which hosts 30 merchants, and c) Prodigy's electronic mall providing customer shopping via a search engine. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Chelliah, IRA, and TForms to implement a search engine to facilitate electronic commerce as taught by BroadVision, in order to help customers find the items they desire, and thereby attract customers to the service.

3. **Claims 54-55 and 62 are rejected under 35 USC 103(a) as being unpatentable over Chelliah (Paper #21, patent number 5,710,887), IRA (a collection of prior art cited in Paper #21, PTO-892, Item: U and PTO-892, Item: U), and TForms (PTO-892, Item: V), as applied to Claim 40, further in view of Proctor (Paper # 15, PTO-892, Item: W).**

Chelliah, IRA, and TForms teach all the above as noted under the 103(a) rejection and teach a) implementing security features (e.g. encrypted tokens for authorization, digital signatures, digital certificates), and b) logging a user's transactions associated with an electronic mall storefront, but do not disclose the monitoring and detection of abusive patterns of use. Proctor teaches the state of the art of intrusion detection systems covering the following topics, but not limited to: monitoring networks and systems for abnormal behavior, and use of audit data to detect patterns of abuse, trending analysis, and audit log reduction and archiving (Paper #15, Item: W, see pages 1-7). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the

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system and method of Chelliah, IRA, and TForms to include intrusion detection system features as taught by Proctor, in order to improve overall system security and performance, and encourage users to use the online service.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US 5,717,923 (Dedrick) 10 February 1998; teaches dynamic customization of information presented to a user based on user profile information.
- X: PR Newswire; "Electronic Form Systems Announces E-Form: First "Smart" Forms Processing Software," 27 July 1987, 2pgs, Dialog file 621 #01047840; teaches electronic forms processing and automatic pre-fill of fields.
- UU: Baker; Ronald; "Are Electronic Forms Available for Business," Best's Review, February 1996, v96n10pg86, 3pgs, Proquest #9446479; teaches electronic forms and pre-fill capabilities.
- VV: Atwell, Robert; "New Productivity Opportunities Emerging," National Underwriter Property, n7pg18, 3pgs, Dialog file 148 #04525154; teaches productivity enhancements with electronic forms and automatic pre-fill capabilities.



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- WW: Alexander, Steve; "Web Marketing Gets Personal," InfoWorld, 12 January 1998, v20n2pg93, 5pgs, Proquest #01996649; teaches BroadVision's profiling customers and personalization based on profiling.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***  
***Washington D.C. 20231***

or faxed to:

703-872-9306 (Official communications; including After Final  
communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.



Robert M. Pond  
Patent Examiner  
October 30, 2004